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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,348	01/04/2005	Toru Ikuta	2224-0237PUS1	5464
2292 7590 01/12/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
KNABLE, GEOFFREY L				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
01/12/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

## Application No.

10/520,348

## Applicant(s)

IKUTA, TORU

## Examiner

Geoffrey L. Knable

## Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008 and 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4/2, 5/2, 6/2, 7/2, 8/2, 12/2, 13/12/2, 14/12/2 and 15/12/2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1,3,4/1,4/3,5/1,5/3,6/1,6/3,7/1,7/3,8/1,8/3,9-11,12/1,13/12/1,14/12/1,15/12/1 and 16-26.

1. Claims 1, 3, 4/1, 4/3, 5/1, 5/3, 6/1, 6/3, 7/1, 7/3, 8/1, 8/3, 9-11, 12/1, 13/12/1, 14/12/1, 15/12/1 and 16-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7-26-2007.

Although applicant appears to suggest that claims 16-20 and 22-26 are also readable on the elections made, as detailed in the notice of non-responsive amendment mailed 4/18/2008, claim 16 as amended and new claim 26 are now in essence a combination of the originally elected invention ("A") and nonelected invention ("B") corresponding to original claim 21 (drawn to a process for producing a rubber reinforced structure in the form of a tire characterized by a specific bonding technique relating to solvent swelling). Lack of unity is however apparent "a posteriori" between the newly claimed invention ("AB") of these claims and the originally elected invention ("A"). In particular, as noted in the notice of non-responsive amendment mailed 4/18/2008, the subject matter (i.e. "A") common to the newly claimed invention ("AB") and the originally elected invention ("A") is the subject matter of originally elected invention ("A") which, for the reasons set forth in the prior art rejections in the first office action, is known and as such is not a technical feature that defines a contribution over the prior art - e.g. note MPEP 1850(II). The inventions "A" and "AB" therefore do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2, 4/2, 5/2, 6/2, 7/2, 8/2, 12/2, 13/12/2, 14/12/2 and 15/12/2 are rejected under 35 U.S.C. 102(b) as being anticipated by Freytag et al. (US 3,596,696) or Buckwalter et al. (US 2,927,051) or Jadamus et al. (US 5,153,076) or Gifford et al. (US 5,198,050) as applied in the last office action.
4. Claims 2 and 5/2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa (US 4,461,795) or Kaido et al. (US 5,938,869) or Lin et al. (US 5,040,583) as applied in the last office action.
5. Applicant's arguments filed 8/28/2008 have been fully considered but they are not persuasive.

Applicant first argument (on page 16 of the response) urges that the prior art does not teach treating with a solvent or vulcanizing to bond directly without adhesive. As to the bonding process involving solvent, again such is considered to represent a non-elected invention and therefore the arguments thereof are moot. With respect to directly bonding without adhesive, it is argued that Freytag et al. and Buckwalter et al. both relate to bonding a fiber or textile to rubber, it being urged that this is distinct from the claim requirements as no interfacial adhesion is required. Claim 2 however simply defines a rubber structure in the form of a tire in which a rubber member is directly bonded to a "resin member". Nothing in this or the other claims defines over the resin member being in the form of a fiber or textile. Further, it is noted that it is not agreed that the bonding of fiber or textile to rubber is "by structure" rather than by interface

adhesion. In particular, Freytag et al. and Buckwalter et al. are specifically directed to *adhering* of the cords/textiles to rubber - if adhesion of the interfaces to each other were not relevant, then there would have been no need for any special adhesive in the rubber (or on the cord).

It is also argued that Jadamus fails to disclose a polyamide resin element. The noted claims however are not restricted to a polyamide element. The argument that Gifford does not require adhesion is refuted by col. 4, lines 4-6 that clearly suggests that a bond between the resin and rubber is formed and is without adhesive.

The argument that Ogawa, Kaido et al. and Lin et al. do not teach the claimed invention because they use an adhesive is noted but unpersuasive as the adhesive layer in each reference is the thermoplastic material layer to which the rubber is bonded. This is entirely consistent with claim 5.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/  
Primary Examiner, Art Unit 1791

G. Knable  
January 5, 2009